

REMARKS

Claims 1-11, 18-20 and 41-45 remain in the application. Claims 12-17 and 21-40 have been cancelled. Applicant greatly acknowledges the withdrawal of all of the rejections contained in the prior Office Action.

NEW REJECTIONS

I. Claims 1-11, 18-20 and 41-45 have been rejected under 35 USC §102(b) as being anticipated by van Driesten et al WO 00/46316 or van Driesten et al EP 1 026 215 A1.

The Examiner has suggested that van Driesten WO '316 discloses an adhesive article comprising a face construct 11, a release layer 13, a pressure sensitive adhesive (permanent) layer 14, a polyester layer 15, a pressure-sensitive adhesive layer 12, a non-PSA layer 2, a release layer 32, a liner layer 37, a pressure sensitive adhesive layer 36, a release layer 33 and a liner layer 31. See claims 1-23 and Fig. 14A. The Examiner further notes that layers 11, 31 and 37 may be made of paper, a plastic film of a polyolefin such as polyethylene and polypropylene, or a polyester such as polyethylene terephthalate (see claims 19-21; page 15, second paragraph). The PSA adhesive and the non-PSA adhesive can be hot melt adhesive and rubber based or acrylic based (see page 9, lines 21-23; page 3, lines 24-37; and page 19, lines 23-36).

The Examiner concludes:

Although the reference does not specifically teach the substrate to be moisture resistant, the adhesive to be removable and resealable in the presence of moisture from food packaging environments, or its Moist Loop Test result, since the reference teaches the same components in the laminate, the laminate would inherently have all of the same properties as presently claimed.

The same arguments are presented with respect to van Driesten EP '215.

Reconsideration and withdrawal of the rejection is solicited. van Driesten neither teaches nor suggests that the PSA adhesive layers are removable and resealable under any conditions. In fact, van Driesten WO '316 discloses that the PSA layers 12 and 36 are composed of pressure sensitive adhesives which are permanent adhesives. See, e.g., page 19, lines 23-25, cited by the Examiner. Accordingly, Applicant respectfully submits that the PSAs described by van Driesten are not comprised of the same components and would not "inherently have all the same properties as presently claimed".

Moreover, there is no teaching or suggestion in van Driesten WO '316 that the PSA can be applied to any other substrate and be subsequently removable and resealable, and accordingly, can neither teach or suggest that the PSAs would be removable and resealable in the presence of moisture from food packaging environments. Finally, van Driesten WO '316 generically describes poly(meth)acrylates, and/or copolymers, and/or derivatives of these polymers and/or copolymers as useful PSA and non-PSA materials. There is no teaching or suggestion that particular polyacrylates should be chosen to provide a removable and resealable adhesive construction. In view of the generic nature of the van Driesten disclosure, it is well established that there is no basis to conclude that the PSAs generically described by van Driesten would inherently be removable and resealable, nor is there any basis to conclude that the PSA would inherently have a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C.

There is no adhesive disclosed by van Driesten which is suggested to have the same Moist Loop Test result as presently claimed. Moreover, even though some of the adhesives included within broad categories of acrylic-based PSAs mentioned in van Driesten might exhibit a Moist Loop Test result within the claimed range, such possibilities or probabilities do not support a rejection based on inherency.

The Examiner has not relied upon any discussion in van Driesten that would suggest these Moist Loop Test results are inherent. The Examiner's position is based solely on his interpretation of van Driesten after reading the present application. As noted in the recent Hunter Douglas Inc. v. Comfortex Corp., 49 USPQ 2d, 1785, 1789 (Fed. Cir. 1998).

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.... Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the question function, it seems to be well settled that the disclosure should be regarded as sufficient. Citing Continental Can Co. USA Inc. v. Monsanto Co., 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991)

The Examiner is requested to reconsider and withdraw the rejection of the claims as anticipated by van Driesten WO '316 and van Driesten EP '215 because there is no extrinsic evidence that the adhesives of the van Driesten patent are (a) always characterized by a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C or (b) the removable adhesive is removable and resealable in the presence of moisture at refrigerated and frozen food packaging environments.

In addition, claims 18-20, 42 and 44 specify that the adhesive article also further comprises (c) at least one permanent adhesive covering a second portion of the first surface of the substrate. Rejection of these claims should be withdrawn because van Driesten neither teaches nor suggests an article containing both a removable adhesive and a permanent adhesive on different portions of the same

surface of a substrate. Since there is no teaching or suggestion of utilizing the combination of a permanent adhesive and a removable adhesive on a surface, the rejection of at least claims 18-20, 42 and 44 as anticipated by van Driesten WO '316 and EP '215 should be withdrawn. The claims are not anticipated.

II. Claims 1-8 and 18 have been rejected under 35 USC §102(b) as being anticipated by Navarini et al U.S. Patent 6,056,141.

The Examiner has noted that Navarini discloses a laminate comprising a top layer 2, a repositionable adhesive 4, an inner layer 3, and a protective layer 5 (column 2, lines 35-51). Adhesive layer 4 is "preferably of acrylic nature" (column 4, line 20) or "preferably of acrylic base" (column 5, line 43). The top layer 2 may be a multilayer comprising an outer support film of paper, PET, OPA, OPP, etc.

The Examiner acknowledges that Navarini does not specifically teach the substrate to be moisture resistant, the adhesive to be removable and resealable in the presence of moisture from food packaging environments, or its Moist Loop Test result. However, the Examiner concludes that since the reference teaches the same components in the laminate, the laminate would inherently have all the same properties as presently claimed.

Reconsideration and withdrawal of the rejection is solicited because it is well settled that, based upon the disclosure of Navarini et al, there is no basis for concluding that "the laminate would inherently have all the same properties as presently claimed". Navarini et al describe the removable and resealable adhesive used in their laminate as being either "acrylic based" or "of acrylic nature". Applicant finds no further detail with regard to the nature of the adhesive. Accordingly, in view of the indefinite nature of the Navarini disclosure and the unlimited number of acrylic based adhesives contemplated as being useful in their invention, Applicant submits that there is no basis for the Examiner's conclusion that the Moist Loop Test result would inherently be found in the laminate described by Navarini et al.

The Examiner has not relied upon any discussion in Navarini that would suggest the Moist Loop Test results are inherent. The Examiner is requested to reconsider and withdraw the rejection of the claims as anticipated by Navarini WO '316 and Navarini EP '215 because there is no extrinsic evidence that the adhesives of the Navarini patent are always characterized by a Moist Loop Test result of at least about 0.8 N/25mm at a test plate temperature of 5°C or that the removable adhesive is removable and resealable in the presence of moisture at refrigerated and frozen food packaging environments. See Hunter Douglas Inc. v. Comfortex Corp., 49 USPQ 2d, 1785, 1789 (Fed. Cir. 1998), discussed above.

III. Claims 1-4, 18, and 41-45 are rejected under 35 USC §102(b) as being anticipated by Bane U.S. Patent 5,366,087.

The Examiner has noted that Bane discloses a label to reseal a package comprising a substrate 11 of paper or plastic, a thermally sensitive coating 12 on one face of the substrate, a perforated line bisecting the substrate, and on the other face of the substrate are coatings 14 and 15 of adhesive on opposite sides of the perforated line. Coating 14 is a permanent PSA and hot melt adhesive, and coating 15 is a repositional adhesive (removable and resealable). See Figs. 1-4; paragraph bridging columns 2-3; and column 3, lines 57-58). A release liner 16 covers the coatings 14 and 15, or coating 12 so as to provide a roll of such labels.

The Examiner acknowledges that the reference does not specifically teach the substrate to be moisture resistant, the adhesive to be removable and resealable in the presence of moisture from a food packaging environment, or its Moist Loop Test result. However, the Examiner has concluded that since the reference teaches the same components in the laminate, the laminate would inherently have the same properties as presently claimed.

Reconsideration and withdrawal of this rejection is solicited. Contrary to the Examiner's allegation, the reference does not teach "the same components in the laminate, and, therefore, the laminate would not inherently have all of the same properties as presently claimed". Applicant has reviewed the Bane disclosure and

do not find any teaching or suggestion of types or classes of permanent or repositional adhesives that can be utilized in the laminates described by Bane. Bane merely mentions in column 3, beginning at line 56 that the adhesives 14 and 15 may be selected from a wide variety of conventional permanent and repositional adhesives. A commercial example of a repositional adhesive 15 is given in column 3, line 68 as CLEAN TAC adhesive from Moore Business Forms Inc. of Forest Lake, Illinois. No further information is presented with regard to the composition of this adhesive, and Bane merely states that this repositional adhesive merely separates from the underlying packaging material and can be reused.

Applicant respectfully submits that there is no teaching or discussion in Bane which would suggest that the Moist Loop Test results recited in the present claims are inherent in the "conventional" repositionable adhesive. Applicant submits that the laminates described by Bane do not inherently have the characteristics of the laminates presently claimed, and the rejection should therefore be withdrawn.

CONCLUSION

In view of the above remarks, Applicant respectfully submits that all of the claims in the application are in condition for allowance. An early action allowing the pending claims is requested.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 under Attorney Docket No. **AVERP3447USA**.

Respectfully submitted,

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